

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket No. 005288.00025

In re U.S. Patent Application of Senthil Sengodan, et al.)	
)	
)	Examiner: Randy Peaches
Application No. 09/986,778)	
)	Group Art Unit: 2617
Filed: November 9, 2001)	
)	Confirmation No. 5639
For: Method of Pre-Authorizing Handovers Among Access Routers in Communication Networks)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-14501

Sir:

Applicants respectfully request review of the outstanding Final Office Action mailed December 24, 2008 and the Advisory Action mailed April 14, 2009 in the above-identified application. No amendments are being filed with this request and this request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. Applicants hereby petition for any applicable extension of time. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Claims 1-4, 9-11, 29, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willars et al. (U.S. Patent Publication No. 2003/0013443 A1) in view of Yukie (U.S. Patent Publication No. 2003/0036392 A1). The remaining claims stand rejected over a combination of references and Applicants respectfully refer the Panel to the previous responses addressing those claims. Applicants traverse the rejections and request that they be overturned by the Panel for at least the following reasons.

A. Comments on Claim 1

The combination of Willars and Yukie, even if proper, fails to teach or suggest “receiving from a first access router in a first network by a second access router in a second network that serves a different service area a request for authorization inquiry including an identifier that identifies a mobile terminal that is a candidate for a handoff operation” or “causing a database to be queried via a server to determine whether the second access router is authorized to accept a handoff operation for the mobile terminal” as claimed in claim 1.

1. The Final Rejection Should have Been Withdrawn

The Office improperly maintained the final rejection in the Advisory Action after dramatically shifting its position from the Final Office Action. After repeatedly asserting that Willars discloses a handoff between first and second networks, the Advisory Action concedes that Willars does not disclose such a handoff and newly alleges that Yukie discloses the claimed handoff. For instance, the Final Office Action asserts:

Regarding **claims 1 and 29**, Willars et al teaches of a method of handing off a user equipment (UE), which reads on claim “mobile terminal”, from a Serving Network, which reads on claim “first network”, served by a Serving Radio Network Controller (SRNC), which reads on claim “first access device”, to a Target or Drift Network, which reads on claim “second network”, served by a Target/Drift Radio Network Controller (DRNC),

See Final Office Action, p. 2. Further, the Final Office Action asserts:

1.), Willars paragraph [0079] wherein Willars teach that a handover algorithm can be for different user equipment wich belong to different PLMN's (Public Land Mobile Networks) which infers that the there can be more than one network in which the teaching of Willars are applicable with. FIGURE 11 illustrates wherein a check is made to determine if a user of a PLMN (A), which read on claim “first network,” is authorized to be handover to PLMN (B) which read on claim “second network,” whereby Willars

Id. at p. 16. Clearly, the finality of the rejection was premised on the Office’s mistaken belief that Willars discloses a handoff between first and second networks. Surprisingly, the Advisory Action dramatically changes its interpretation and now indicates:

Continuation of 11. does NOT place the application in condition for allowance because: The Applicant argues that Willars does not teach or suggest a handover between different networks; rather, Willars only discloses one network. The Examiner, as cited in the office action agrees with the Applicant; however, the Examiner includes Yukie to remedy the missing elements of a handover from a first network to a second network.

See Advisory Action, p. 3. Thus, the Office now concedes that Willars does not disclose a handover between networks, and appears to be relying on Yukie to disclose a handover between first and second networks.

This is a new interpretation of Yukie and a new rejection. In the Final Office Action, the Office alleged that Yukie disclosed a first and second access router of two different networks to cure the deficiency in Willars, but did not assert that Yukie discloses handoffs. See Final Office Action, p. 3. Now, the Advisory Action sets forth a new interpretation of Yukie as allegedly disclosing handoffs. See Advisory Action, p. 3. Accordingly, claim 1 has not been twice rejected under such an interpretation, and hence a final rejection is premature and improper. Moreover, maintaining finality of the rejection under this new interpretation has unfairly eliminated Applicants's ability to respond absent pursuit of an appeal. Therefore, Applicants respectfully request that the finality of the rejection be withdrawn and, if necessary, issuance of a non-final Office Action fully explaining the new rejection.

2. *Yukie Fails to Cure the Deficiency in Willars*

Yukie fails to disclose a handoff between first and second networks to cure the deficiency in Willars for at least the following four reasons.

First, Yukie fails to use the terms handover or handoff, and hence does not support the new interpretation set forth in the Advisory Action.

Second, Yukie does not disclose how to make a handoff from a first access router to a second access router as claimed in claim 1. Indeed, the Final and Advisory Office Actions do not identify any alleged first access router or second access router in Yukie as claimed in claim 1, much less any disclosure in Yukie of "receiving from a first access router in a first network by a second access router in a second network that serves a different service area a request for authorization inquiry including an identifier that identifies a mobile terminal that is a candidate for a handoff operation" or "causing a database to be queried via a server to determine whether the second access router is authorized to accept a handoff operation for the mobile terminal."

Third, there is no teaching in Yukie of pre-authorizing handovers among access routers in first and second networks. As disclosed in the instant application, pre-authorizing handovers among access routers in communication networks solves the problems (such as wasted resources and frequency spectrum, and delayed handover processing) encountered in prior methods wherein a mobile terminal is handed over to a new access router, and then an authorization

process ensues to determine whether the mobile terminal is authorized to roam into a new network. *See* paragraphs 11-15 of the specification of the present application as originally filed.

Paragraphs 0022, 0026, and 0030 of Yukie, cited in the Advisory Action, fail to disclose pre-authorizing handoffs among access routers in first and second networks. Paragraph 0022 of Yukie describes a mobile unit communicating via first and second networks; paragraph 0026 describes a gateway 250 providing a conversion between identifiers used by different networks; and paragraph 0030 describes roaming between networks and that “[t]erminal 205 selects which network to use according to selection criteria, such as data rate, cost, energy consumption, or a combination of criteria.” None of the cited paragraphs disclose pre-authorizing handoffs among access routers in first and second networks. Therefore, the proposed combination of Willars and Yukie does not teach or suggest all aspects of claim 1 and hence does not support a *prima facie* case of obviousness.

Fourth, the proposed combination of Willars and Yukie is not proper. As noted in the Advisory Action, Willars merely discloses a single network. The Final and Advisory Office Actions do not provide any reason why it would have been obvious to one of ordinary skill in the art at the time of filing to modify Willars to include a second network as taught in Yukie, and then to further modify the proposed combination to provide “receiving from a first access router in a first network by a second access router in a second network that serves a different service area a request for authorization inquiry including an identifier that identifies a mobile terminal that is a candidate for a handoff operation” or “causing a database to be queried via a server to determine whether the second access router is authorized to accept a handoff operation for the mobile terminal” as claimed in claim 1.

There is also no suggestion to combine the teachings of Willars with Yukie and modify them in a manner that results in claim 1, except using Applicants’s invention as a template through a hindsight reconstruction of Applicants’s claims. Such hindsight reconstruction is improper under *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR*).

Therefore, Applicants submit that a *prima facie* case of obvious to reject claim 1 has not been established in view of Willars and Yukie and respectfully request that the Panel overturn the rejection under 35 U.S.C. § 103.

B. Comments on other Pending Claims

To address the other pending claims, Applicants invite the Panel to consider the Request for Reconsideration filed March 20, 2009 and the Response filed September 12, 2008. Notably, there is nothing in Willars, Yukie or Funato that indicates that one of ordinary skill in the art would have recognized such a proposed combination or the benefits thereof. *See* Response filed September 12, 2008, p. 13. The Office Action fails to provide articulated reasoning and rationale underpinning to support the legal conclusion of obviousness, and, as such, a rejection cannot be sustained. *Id.*

CONCLUSION

For at least this reason, Applicants respectfully request reconsideration and reversal of the rejection. All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5000.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Date: May 26, 2009

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